REMARKS

Claims 1-9 and 27-59 are pending and are the subject of the office action mailed April 22, 2004.

Objection to Specification

The Examiner objected to the specification on grounds that the brief description of Figures 2 and 7 in the application do not include proper sequence identifiers. Applicants are providing herewith a substitute Sequence Listing (paper and computer readable form) which now includes the sequences referred to in Figures 2 and 7. In the Amendment above, entry of this substitute Sequence Listing into the specification is requested, and the Brief Description of the Drawings has been amended to recite the specific SEQ ID NO:s for each of the respective sequences. A Certificate re Sequence Listing is also being filed herewith.

Section 102 Rejection

The Examiner has maintained the rejection under Section 102(e) based on Yu et al., US Patent 5,998,171. Applicants again request withdrawal of this rejection on the basis that the Yu et al. patent is not a reference which qualifies as "prior art" under Section 102(e).

As stated in Applicants' previous response, it would appear that the Office has not been able to establish a workable and equitable policy on the very issues presented by the instant application and the facts of this case. On the one hand, the Office is applying stringent utility and enablement requirements on pending patent applications and yet the Office has issued a category of patents, such as the Yu et al. patent, where the disclosure of such patents merely disclose a sequence and nothing more. Although the Yu et al. patent provides

structural information concerning endokine alpha, it fails to teach one of ordinary skill how to use such an endokine alpha polypeptide (or a DNA encoding it). The patent provides no functional data to suggest how the endokine alpha polypeptide or its' DNA may be used.

The Examiner contends that a reference need not teach a utility in order for it to be anticipitory art. It is Applicants' position that the Office cannot and should not rely upon on certain decisions which are not applicable to the present situation in order to artificially construct a means by which to deal with patents such as Yu et al. that clearly do not meet the patentability requirements of utility and enablement, and which, if they had been examined pursuant to the current guidelines under Section 101 and 112, would never have issued as patents. The Examiner is referred to In re Wertheim, 646 F2d 527, 209 USPQ 554 (CCPA 1981), as well as MPEP 2136.03, sub-heading IV, which provide that the claims of a reference patent must be supported in the manner required by 35 USC 112 in the priority application whose date is relied on to establish the prior art status of the patent. The disclosure of such a priority application must include a use that supports the claims under Section 112. If it does not, that priority application is simply not available as part of the prior art.

As suggested in Applicants' previous response, in the event that the Examiner further maintains the instant rejection based on Yu et al., it may be that a suspension of examination of the instant application should be issued until such a time as the Office can establish an equitable policy with respect to the very issues presented in these circumstances.

Double Patenting Rejection

Applicants acknowledge the provisional double patenting rejection of claims 1-2 and 27-59 over claims 27-61 of co-pending

application no. 10/080,455. The rejection is requested to be held in abeyance until allowance of the claims in the instant case or co-pending application has been determined.

Respectfully submitted,

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